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## II. REMARKS

Applicants submit that the present amendments, which adopt the suggestions by the Examiner, require only a cursory review by the Examiner and place the claims in condition for allowance. The presented amendments do not change the scope of the invention; nor do they require a new search. Thus the amendments do not put an undue burden upon the examiner.

Accordingly, entry of these amendments after final rejection is respectfully requested.

### 1. Status of the Claims

Claims 42, 43, 46-49, 64-69 and 71-74 are pending in this application. In the above amendment, Claims 65 and 68 have been canceled and Claims 42, 43, 64, 71, and 72 have been amended. Upon entry of the above amendments, Claims 42, 43, 46-49, 64, 66-67, 69, and 71-74 are pending in this application.

### 2. Summary of the Amendments

Claim 42 has been amended such that "w" is independently 1 or 2, to claim the subject matter of Claims 66-67 (which the Examiner indicated would be allowable), and to delete "non-elected inventions." Specifically, R<sup>5</sup> and R<sup>6</sup> are now independently hydrogen or C<sub>1-10</sub>alkyl; and "y" is now 1. Support for these amendments may be found, for example, on page 45, lines 15-16; and page 46, lines 7-8, and lines 17-18, in the original specification as filed.

To correct an inadvertent error, Claims 42 and 43 have been amended to add "halo" to the Markush group definitions of R<sup>1</sup> and R<sup>7</sup> respectively. Support for these amendments may be found in original Claim 3 and on page 45, lines 15-18 and page 48, lines 24-26 of the original specification as filed.

Claim 43, previously dependent upon Claim 42, has been rewritten in independent form. In accordance with the Examiner's restriction, Claim 43 has been amended such that Q is -CR<sup>5</sup>R<sup>6</sup>- wherein R<sup>5</sup> and R<sup>6</sup> are independently hydrogen or C<sub>1-10</sub>alkyl; and "y" is 1. Support for this amendment may be found, for example, on page 46, line 26 through page 48, line 23, and page 46, lines 24-26 of the original specification as filed.

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Claim 64 has been amended to correspond with amended Claim 42, such that structures in which "y" is other than 1 have been deleted.

Please cancel Claims 65 and 68 without prejudice or disclaimer.

Claim 71 has been amended to correspond with amended Claim 42. Compounds that are outside of the values of amended Claim 42 have been deleted. Specifically, compound nos. 3, 11, 32, 54, and 118 (where "y" is other than 1); compound nos. 23 and 59 (where R<sup>5</sup> and R<sup>6</sup> are other than hydrogen or C<sub>1-10</sub>alkyl); and compound nos. 19 and 49 (where w is 0) have been deleted.

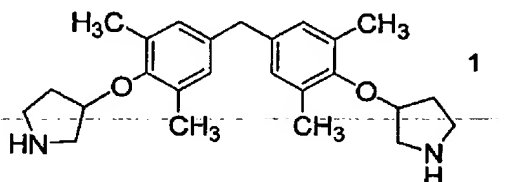
Claim 72 has been amended to delete reference to canceled Claims 65 and 68.

No new matter has been added. Entry of the above amendments is respectfully requested.

3. Election/Restriction

Applicants elected, as summarized by the Examiner on page 2 of the May 20, 2003 Office Action, "Restriction Group I, Claims 40-59 and 61-74 drawn to compounds of formula (I), formula (XXIX), or formula (XXX) where Y is heterocyclyl having one nitrogen atom as the only ring heteroatom, corresponding composition and method of use."

Applicants further elected compound 1, which is depicted in Table 1 on page 5 of the specification and is shown below for the Examiner's convenience. Compound 1 was previously searched by the Examiner and found free of prior art.



4. Final Office Action dated October 22, 2003

In the October 22, 2003 Final Office Action, the Examiner rejected Claims 42, 43, 65, 68 and 69 under 35 U.S.C. 102(b) as being anticipated by Renner et al., CAPLUS Abstract

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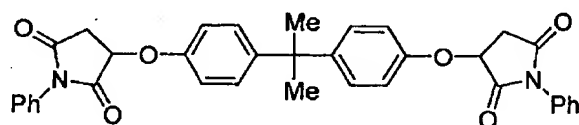
89:110472 (1978). Previously, the examiner had searched on the elected species where Q equals  $-\text{CH}_2-$ , and "y" is 1 (i.e., pyrrolidine). The Examiner's search was expanded to include compounds where Q is  $-\text{CR}^5\text{R}^6-$ . As noted on page 4, lines 6-7 of the Final Office Action, "All other values of Q and y are hereby withdrawn from consideration by the examiner pursuant to 37 CFR 1.142(b), as being drawn to non-elected inventions."

Additionally, the Office Action indicated that "Claims 46-49, 64-67, 71 and 73-74 were objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitation of the base claim and any intervening claims."

Claim 72 was objected to under 37 C.F.R. 1.75(c) as being improperly dependent upon another multiple dependent claim.

5. Claim Rejection Under 35 U.S.C. §102(b)

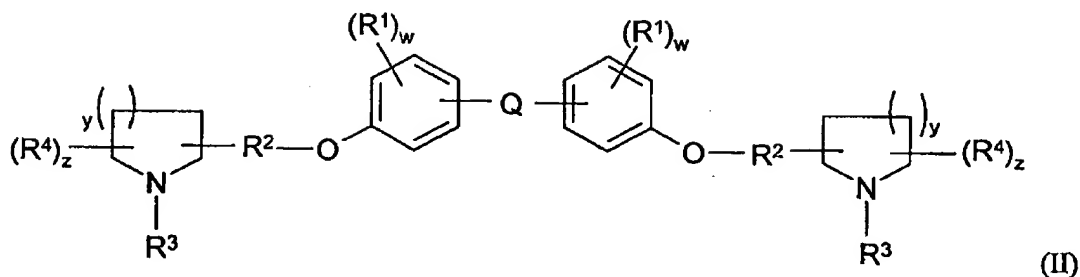
The Examiner rejected Claims 42, 43, 65, 68 and 69 under 35 U.S.C. §102(b) as being anticipated by Renner et al., CAPLUS Abstract 89:110472 (1978). Renner synthesized a series of phenoxy succinimide compounds, including the compound referred to as RN 67354-88-5, shown below for the Examiner's convenience. Note that the phenyl rings of Renner's 1,1-dimethyl bisphenylmethane core are unsubstituted.



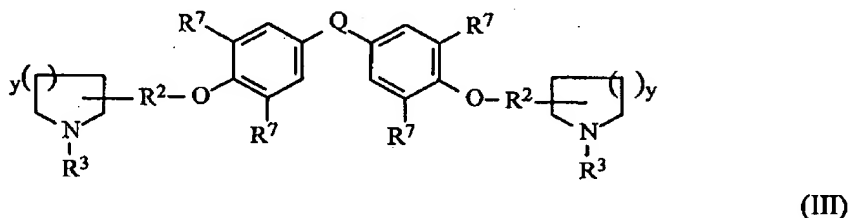
RN: 67354-88-5

Applicants' Claim 42 has been amended to claim the subject matter of Claims 66-67 which the Examiner has indicated would be allowable. Claim 42 now claims a compound of formula II (shown below) in which "w" is independently 1 or 2. Since "w" is either 1 or 2, the core phenylene rings each independently must have either 1 or 2 substituents. Renner et al.'s compound RN 67354-88-5 does not teach substituents on the bis-phenyl core. Since Renner et al. does not teach all of the claim limitations, it does not anticipate Applicants' Claim 42.

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Applicants respectfully traverse the rejection of Claim 43 for the following reasons.  
 Claim 43 claims a compound of formula III shown below for the Examiner's convenience.



In Applicants' formula III, there is no substitution of the carbon atoms of the pyrrolidinyl rings, and substitution of the nitrogen atom of the pyrrolidinyl ring ( $R^3$ ) is selected from hydrogen,  $C_{1-10}$ alkyl, or oxo. In contrast, Renner synthesized "phenoxysuccinimides." The nomenclature "succinimide" refers to a pyrrolidinyl ring in which the carbon atoms in the 2- and 5 position are substituted by  $=O$ . In addition, specific to Renner's compound, the nitrogen atom of the succinimide is substituted by phenyl.

Since Applicants' Claim 43 does not allow the carbon atoms of the pyrrolidine ring to be substituted, and since substitution at the nitrogen atom of the pyrrolidine ring can only be hydrogen,  $C_{1-10}$ alkyl, and oxo, Applicants' claims do not read on Renner's compound RN 67354-88-5. Thus, Claim 43 is not anticipated by Renner et al. and removal of this rejection is respectfully requested.

Claims 65 and 68 have been canceled; therefore their rejection is moot.

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Claim 69 depends from Claim 42, and defines the values for "z", the number of R<sup>4</sup> substituents. Since Claim 42 has been amended to correspond with "objected to" Claims 66-67, which the Examiner indicated are allowable, and since Claim 69 is dependent from amended Claim 42, the rejection has been obviated.

For at least the above reasons, Applicants respectfully request reconsideration of the rejection of Claims 42, 43, 65, 68 and 69 under 35 U.S.C. §102(b) as being anticipated by Renner et al., CAPLUS Abstract 89:110472 (1978), and request that it be removed.

6. Claim Rejections Under 37 C.F.R. §1.75(c)

Claim 72, a multiply dependent claim, was objected to under 37 C.F.R. §1.752(c) as being in improper form because Claim 72 referred to Claim 68 which was also a multiple dependent claim. In the above amendments, Claim 68 has been canceled, and Claim 72 has been amended accordingly.

Removal of this rejection is respectfully requested.

7. Allowable Subject Matter

In the October 22, 2003 Final Office Action, the Examiner indicated that "Claims 46-49, 64-67, 71 and 73-74 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitation of the base claim and any intervening claims."

In order to expedite the issuance of claims that the Examiner indicated would be allowable, Applicants respectfully request that the above amendments be entered.

Applicants submit that the amendments presented herein put pending Claims 42, 43, 46-49, 64, 66-67, 69 and 71-74 in condition for allowance.

Claim 42 has been amended to claim the subject matter of Claims 66-67 which the Examiner indicated is allowable and to incorporate the election of species.

Claim 43 has been rewritten as an independent claim, and is not anticipated by Renner et al. Thus, Claim 43 is allowable.

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The Examiner has indicated that the subject matter of Claims 46-49, 64, 66 and 67 is allowable.

Claim 65 and 68 have been canceled.

Claim 69 is dependent on Claim 42, which has been amended to claim the subject matter of Claims 66-67, which the Examiner indicated is allowable.

The Examiner has indicated that the subject matter of Claim 71 is allowable.

Multiply dependent Claim 72 no longer depends upon another multiply dependent claim, and is allowable.

The Examiner has indicated that the subject matter of Claims 73 and 74 is allowable.

Accordingly, Applicants submit that all pending claims are now in condition for allowance, and respectfully request the prompt issuance of a Notice of Allowance.

In the event that a telephone conference could expedite prosecution of the instant application, the Examiner is invited to telephone Roberta Saxon, agent of record for Applicants at (650) 808-3764, or the undersigned agent at (650) 808-6144.

Respectfully submitted,

Date: January 16, 2004

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